



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Laszlo Papai

Attention: Box issue fee

Serial No: 10/071,923

Confirmation No. 9881

Filed: February 5, 2002

Examiner: Hoa Van Le

For: STABILIZED CD-4 ONE-  
PART FILM DEVELOPER CONCENTRATES

CERTIFICATE OF MAILING  
37 CFR. 1.8

I hereby certify that this Amendment is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:

3/4/03  
DATE

Linda Case  
SIGNATURE

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE  
(37 CFR 1.104(e))

Commissioner for Patents  
Washington, DC 20231

Dear Sir:

Applicant hereby requests entry of this paper into the file wrapper history of the captioned application, and that it be made a permanent part of the Official file history of the United States Patent, when issued.

COMMENTS

The Notice of Allowance in the matter of the captioned application, mailed February 21, 2003, includes *inter-alia* an Examiner's Statement for Reasons for Allowance of claims 1-19.

In this regard, the MPEP (Manual of Patent Examining Procedure, Eighth Ed) Section 1302.14 provides guidelines beginning at pages 1300-10 for examiners who wish to provide reasons for allowance. More specifically, page 1300-10 of the Official guidelines of the USPTO expressly provides:

"Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims."

In this regard, Examiner Hoa Van Le's reasons for allowance begin at page 2, IV (1) of the attachment to the Notice of Allowance. There, the examiner mentions it is "allowed" (i.e., permissible) for claims to recite a characteristic or chemical property of a material by functional language, citing as authority *In re Swinehart et al* 169 USPQ 226 (CCPA 1971).

Although the claim language referenced by the examiner in his comments is not totally clear, nevertheless it would appear from the examiner's remarks appearing at the top of page 3 that he is making reference to language appearing in allowed claims 1, 5 and 12, which state "...characterized by satisfactory developer performance".

The examiner's observational comments in Section IV relative to the allowed claims are contradictory and introduce confusion into the record, where on one hand he acknowledges that functional, characteristics or chemical properties of a material are "allowed" (i.e. permissible) for use in claims, but incorrectly urges that functional expressions carry with them "risk", once again, citing *Swinehart supra.* at page 228, as authority.

The Examiner's overall negative and contradictory comments relative to the above language appearing in allowed claims 1, 5 and 12 are not in compliance with Office guidelines for examiner's comments on reasons for allowance, as recited in the MPEP Sect. 1302.14 ( page 1300-10). In sum, Applicant disagrees with the examiner's comments accompanying the Notice of Allowance because they are inaccurate, contradictory and potentially prejudicial.

The examiner appears to be relying on Swinehart *supra.* for the proposition that use of functional language, while permissible nevertheless may not be in the best interests of the public. The examiner characterizes claims containing functional language as presenting "risks", and thereby, possibly implying such claims might possibly be unenforceable. However, the examiner's reliance on Swinehart does not support his negative views relative to functional or characterizing language appearing in the allowed claims.

According to Swinehart *supra.* at page 228 the Court said:

In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical necessity for the use of functional language. See, for example, *In re Halleck*, 57 CCPA 954, 421 F.2d 911, 164 USPQ 647 (1970) We recognize that prior cases have hinted at a possible distinction in this area depending on the criticality of the particular point at which such language might appear. Our study of these cases has satisfied us, however, that any concern over the use of functional language at the so-called "point of novelty" stems largely from the fear that an applicant will attempt to distinguish over a reference disclosure by emphasizing a property or function which may not be mentioned by the reference and thereby assert that his claimed subject matter is novel. Such a concern is not only irrelevant, it is misplaced. In the first place, it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it [Patent Office] possesses the authority to require the applicant to prove the subject matter shown to be in the prior art does not possess the characteristic relied on. (Emphasis added)

Accordingly, Swinehart *supra.*, contrary to the examiner's comments on the reasons for allowance, does not stand for the

proposition that so called "functional" language appearing in claims (claims 1, 5 and 12) presents "risk." Quite to the contrary. Swinehart clearly supports functional language and the fact that it does not present risks as advocated by Examiner Le because any newly discovered properties of an otherwise old or known composition (or product) does not lend patentable novelty thereto. Examiner Le, of course, could have rejected the claims if he so chose, but apparently decided otherwise and found claims 1-19 to be patentable over the references of record.

Section VI, particularly paragraphs 2 and 3 on page 3 of the examiner's statement for reasons for allowance are also quite inaccurate in the discussion of Hashimoto et al (US 5,891,608). Hashimoto et al disclose a substantial number of phenylenediamine type developing agents, including salts. Included among this thicket of possible developers is the developer known in the trade as CD-4 or 4(N-ethyl-N-2-hydroxyethyl)-2-methylphenylenediamine. Also included in Hashimoto et al beginning at col. 20 is a large number of hydroxylamine derivatives for use as preservatives with the phenylenediamine type developers, including N,N-bis(2-sulfoethyl) hydroxylamine (SEHA). According to Hashimoto et al, it is permissible to use any of the many hydroxylamine derivatives with any of the phenylenediamine developers in preparing their developer slurries. However, Applicant found this implied general representation of Hashimoto et al, and other similar type references, not to be correct.

In this regard, Hashimoto et al simply do not appreciate or deal with the special stability problems associated with the preparation of CD-4 developer concentrates, nor do they teach or suggest as to render obvious the unexpected and surprising results achieved with applicant's discovery, namely that CD-4 type developer concentrates can be stabilized provided a particular hydroxylamine derivative is used, namely SEHA.

Contrary to the Examiner's comments appearing on page 3 of the

examiner's reasons for allowance, Hashimoto et al simply do not teach, suggest, demonstrate or reduce to practice Applicant's particular combination of CD-4 developer and SEHA alone, or SEHA in combination with one or more other hydroxylamine derivatives. Even when the entire lengthy disclosure of Hashimoto et al is viewed, taken as a whole, one of ordinary skill in this art would still not be directed to applicant's particular combination. The fact remains the prophetic portions of Hoshimoto et al disclose many developers and many hydroxylamine preservatives, but there is no teaching of the special stability problems associated with 4(N-ethyl-N-2-hydroxyethyl)-2-methylphenylenediamine developer, and how it can be solved selectively with a particular hydroxylamine derivative, namely N,N-bis(2-sulfoethyl) hydroxylamine (SEHA). One of ordinary skill in the art would not learn this from a reading of Hashimoto et al because it is not a teaching reference.

Importantly, the reasons cited by the examiner in Section VI(3) on page 3 of the examiner's statement of reasons for allowance, all relating to the inability of the Office to test the properties of the compositions of those of Hashimoto et al have no bearing on the patentability of allowed claims 1-19.

More correctly, because Hashimoto et al fail to teach or suggest applicant's specific combination of active ingredients, namely CD-4 developer in combination with SEHA precludes an inherency rejection under 35 U.S.C. 102, and also precludes making out a *prima facie* case of obviousness under 35 U.S.C. 103. Accordingly, claims 1-19 are patentable irrespective of Hashimoto et al's failure to expressly teach the additional feature recited by the claims, namely ".....said composition characterized by satisfactory developer performance."

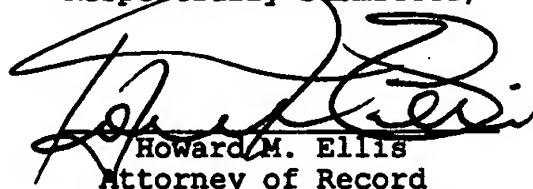
Finally, Section VI, Part (4) at page 4 of the examiner's statement of reasons for allowance attempts to define Applicant's (patentee) future burden in the event of patent litigation. With

the legal presumption of validity, the initial burden of proof in the event of litigation is not that of the patentee. But, more importantly, the issue of patentability of the claimed subject matter in a pending patent application is the only issue the USPTO is given statutory authority over. It is not the Office's domain to comment on issues of domination and enforceability of patent claims in the event of litigation ("contest" as stated by the examiner). In acting on behalf of the Commissioner of Patents, Examiner Le's comments appearing in Section (4) at page 4 are outside the statutory authority of the Office.

Accordingly, the examiner's comments appearing in Section VI(4) on page 4 of the examiner's statement of reasons for allowance, like the others discussed above, should be accorded no weight in the future enforceability of the patent issuing on this application.

March 4, 2003

Respectfully submitted,



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